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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,751

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Roger Picano

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EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

07/20/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,751	<b>Applicant(s)</b> PICANO ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☒ Claim(s) 21, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Acknowledgement of Receipt/Status of Claims***

This Office Action is in response to the amendment filed April 12, 2010. Claims 12-31 are pending in the application and are being examined for patentability.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### **Withdrawn Rejections**

The rejection of claims 12-31 under 35 U.S.C. 103(a) as being unpatentable over Astrid et al. (DE 10333253, machine translation attached) in view of Golz-Berner et al. (US Patent 6,989,150 B1, previously cited in the Office Action mailed on April 16, 2009) **is withdrawn** in view of Applicant's arguments that Astrid et al. is not available as prior art with respect to the present claims.

The rejection of claims 12-21 and 26-30 under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560) in view of Golz-Berner et al. (US Patent 6,989,150 B1) **is withdrawn** in view of Applicant's arguments that Yasuda et al. and Golz-Berner et al. do not teach component c, at least one of sericin and a hydrolyzate of sericin, of the instant claims.

The objection of claims 21, 23 and 24 **is maintained**.

### ***Claim Objections***

Claims **21, 23 and 24** are objected to because of the following informalities:

There are words written in all capitol letters in the claims which is improper. Appropriate correction is required.

### ***Examiner's Response to Applicant's Remarks***

Applicant requests to hold in abeyance the objection of claims 21, 23 and 24. However, the objection has been maintained until Applicant amends the claims.

### **New Rejections**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 12-21 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560, previously cited in the Office Action mailed on April 16, 2009) in view of Golz-Berner et al. (US Patent 6,989,150 B1, previously cited in the Office Action mailed on April 16, 2009) and SCHULZE et al. (WO2004024176 A1, machine translation attached).**

***Applicant's Invention***

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Applicant claims a cosmetic preparation comprising (a) a protein hydrolyzate from at least one of silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Yasuda et al. teach a hair dye composition containing (A) 0.001-20 (esp. **0.01-5**) **wt.%** of protein hydrolyzate(s) such as **keratin** protein hydrolyzate(s), **collagen** protein hydrolyzate(s), **silk** protein hydrolyzate(s) **or elastin** protein hydrolyzate(s) and (B) 0.001-20 (esp. 0.01-5)wt.% of **amino acid**(s) (derivative(s)) such as glycine, (phenyl)alanine, valine, leucine, serine, threonine, tyrosine, asparagine (aspartic acid), cysteine, histidine, arginine, glutamine, pyrrolidonecarboxylic acid and salt(s) thereof (abstract, claims 12, 15-17, 21, 22-24, 28-31 of instant application).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of an extract from mussel threads of mussels and at least one antioxidant in an amount of 0.1 to 10% of the composition. This deficiency in Yasuda et al. is cured by Golz-Berner et al. Golz-Berner et al. teach a cosmetic preparation comprising extracts of byssus (mussel silk)

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(see claim 8 of Golz-Berner et al.) and an extract of the silkworm obtained by extraction, containing a vitamin mix in a range from 0.1 to 10 percent by weight (column 2, lines 8-10).

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of at least one sericin and a hydrolyzate of sericin. This deficiency in Yasuda et al. is cured by SCHULZE et al. SCHULZE et al. teach cosmetic preparations containing a synergistically effective active substance complex made of sericine and fibroin and/or the derivatives (hydrolyzed and/or other derivatized Sericin) thereof for the treatment of skin and hair (abstract).

The difference between the invention of the instant application and that of Yasuda et al. is that Yasuda et al. do not expressly teach the use of taurine, carnitine, creatine or glutathione.

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the Yasuda et al., Golz-Berner et al. and SCHULZE et al. to arrive at a cosmetic preparation for the hair comprising an extract from mussel threads of mussels and at least one of sericin and a hydrolyzate of sericin. One would have been motivated to make this combination in order to receive the expected benefit of having a composition that as a source of a biotechnological protein

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(see claim 8 of Golz-Berner et al.) In addition, both Yasuda et al., Golz-Berner et al. and SCHULZE ZUR WIESCHE et al. teach cosmetic compositions as instantly claimed. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two cosmetic compositions set forth *prima facie* obvious subject matter.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the Yasuda et al. to arrive at a cosmetic preparation for the hair comprising taurine. It is known that taurine is an amino acid. Yasuda et al. teach the use of amino acids selected from glycine, (phenyl)alanine, valine, leucine, serine, threonine, tyrosine, asparagine (aspartic acid), cysteine, histidine, arginine and glutamine. Thus, absent a showing of unexpected results, the instant claims would have been obvious because the substitution of one known amino for another would have yield predictable result to one of ordinary skill in the art at the time of the invention.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed



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invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Claims 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHULZE et al. (WO2004024176 A1, English equivalent attached) in view of Golz-Berner et al. (US Patent 6,989,150 B1, previously cited in the Office Action mailed on April 16, 2009).**

#### ***Applicant's Invention***

Applicant claims a cosmetic preparation, specifically a **shampoo**, comprising (a) a protein hydrolyzate from at least one of silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional.

#### ***Determination of the scope and the content of the prior art (MPEP 2141.01)***

SCHULZE et al. teach cosmetic preparations containing a synergistically effective active substance complex made of sericine and fibroin and/or the derivatives thereof for the treatment of skin and hair (abstract). SCHULZE et al. teach that (A1) in the active substance complex (A) is selected from :

1. **Sericin,**

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2. **hydrolyzed** and/or other **derivatized Sericin**, as for example commercial products with the INCI - designations Sericin, Hydrolyzed Sericin, or **Hydrolyzed Silk**,
3. mixture from **amino acids** serine, aspartate and glycine and/or their methyl, Propyl, ISO Propyl, Butyl, ISO butyl ester, whose salts as for example hydrochlorides, sulfates, acetates, citrates, tartrates, whereby in this mixture the serine and/or its derivatives are contained to 20 to 60 % of the composition , the aspartate and/or its derivatives to 10-40 % of the composition and the glycine and/or its derivatives to 5 to 30,% of the composition ( see page 7a, lines 1-25).
4. mixtures of 1-3.

SCHULZE et al. teach that (A2) in the active substance complex (A) is selected from:

1. hydrolyzed and/or other derivatized fibroin, particularly part-hydrolyzed Fibroin, which contains the **amino acid** sequence Ser Gly Ala Gly Ala Gly as major constituent,
2. the amino acid sequence Ser Gly Ala Gly Ala Gly,
3. mixture of amino acids glycine, alanine and tyrosine and/or their methyl, Propyl, ISO Propyl, Butyl, ISO butyl ester, whose salts as for example hydrochlorides, sulfates, acetates, citrates, tartrates, whereby in this mixture the glycine and/or its derivatives are contained in amounts of 20-60 % of the composition and the alanine and its derivatives in amounts of 10-40 % by weight of the composition and the tyrosine and its derivatives in amounts from 0 to 25% by weight of the composition, or
4. mixtures of 1-3 (see pages 7a, line 26 bridging to page 8, lines 1-12).

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SCHULZE et al. teach that the active substance complex (A) is **0.001-10 %** of the cosmetic composition (see page 3) and that the two active ingredients (A1) and (a2) are used in the ratio from 10:90 to 70:30, in particular 15:85 to 50:50 and whole 20:80 to 40:60 (see page 8, lines 19-22). SCHULZE et al. also teach the use of **ascorbic acid** (see page 42, lines 13-16) antioxidant of instant application) and **collagen** as additives(see page 30, lines 14 bridging to page 31). SCHULZE et al. teaches that the aforementioned agents/components contain the active ingredients preferred in a suitable aqueous, alcoholic or aqueous-alcoholic carriers for example creams, emulsions, **gels** or also foaming solutions, such as **shampoos**, foam aerosols or other preparing, which are suitable for the application on the hair (see pages 50-51).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of SCHULZE et al. is that SCHULZE et al. do not expressly teach the use of an extract from mussel threads of mussels and at least one antioxidant in an amount of 0.1 to 10% of the composition. This deficiency in SCHULZE et al. is cured by Golz-Berner et al. Golz-Berner et al. teach a cosmetic preparation comprising extracts of byssus (mussel silk) (see claim 8 of Golz-Berner et al.) and an extract of the silkworm obtained by extraction, containing a vitamin mix in a range from 0.1 to 10 percent by weight (column 2, lines 8-10).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the SCHULZE et al. and Golz-Berner et al. to arrive at a cosmetic preparation for the hair comprising an extract from mussel threads of mussels. One would have been motivated to make this combination in order to receive the expected benefit of having a composition that as a source of a biotechnological protein (see claim 8 of Golz-Berner et al.) In addition, both SCHULZE et al. and Golz-Berner et al. teach cosmetic compositions as instantly claimed. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two cosmetic compositions set forth *prima facie* obvious subject matter.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Examiner's Response to Applicant's Remarks***

Applicant's arguments filed on April 12, 2010, with respect to the 103 rejection of claims 12-31 under 35 U.S.C. 103(a) as being unpatentable over Astrid et al. (DE 10333253) in view of Golz-Berner et al. (US Patent 6,989,150 B1) have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed on April 12, 2010 with respect to the 103 rejection of claims 12-21 and 26-30 under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560) in view of Golz-Berner et al. (US Patent 6,989,150 B1) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The claims remain rejected.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney A. Brown whose telephone number is 571-270-3284. The examiner can normally be reached on 9:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Johann R. Richter/  
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